

Application No.: 10/026,171  
Response dated: May 30, 2006  
Reply to Office Action of March 9, 2006

### **REMARKS**

Reconsideration of the present claims, in light of the above claim clarifications and the Remarks which follow, is respectfully requested.

Claims now before the Examiner are 1, 3, 5-12, 14-22 and 24 -35.

All the amendments to the claims have been discussed in earlier papers as to their location in the specification or claims as filed.

The numbering in this Response will follow that of the Examiner's Action.

1. & 2. No response necessary.

3. Claim 33 has been renumbered as such from the previous numbering of 35.

#### **Rejections under 35 USC § 112**

4. *Claims 1, 5, 6, 8, 10, 14, 21, 27, 28, 29, 30 and 35 stand Rejected under 35 USC § 112, second paragraph.*

Each of claims 1, 5, 6, 8, 10, 14, 21, 30 and 35 are said to contain improper Markush language. Applicants do not agree, however to move prosecution along, each of the claims except for claim 5 has been amended. Claim 5 did not contain a Markush Group.

Each of claims 1, 5, 6, 8, 10, 27, and 29 have been amended as required by the Examiner.

Withdrawal of the Rejections is respectfully requested.

#### **Rejection Under 35 USC § 103**

5. & 6. *Claims 1, 3, 5-10 and 14-22 stand Rejected under 35 USC § 103(a) as Obvious over each of Razavi I and Razavi II.*

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The Examiner opines that these claims are Obvious over either of these references and that the lesser fouling found in the Rule 132 declaration appears to have been a motivation for both Razavi documents. This judgment is in error. Lower reactor fouling seems indeed to have been a part of the intent of the Razavi documents, however, the Examiner is ignoring the fact that the solution to the fouling problem is different in the present claims from Razavi. Specifically, nowhere in Razavi is a temperature above 50°C disclosed or suggested for the reaction of the metallocene and the activator. Applicants once again state that had Razavi looked for or found any interesting fouling behavior above 25°C (the highest temperature exemplified for the metallocene/activator reaction), Razavi surely would have mentioned it, giving rise to the "motivation" that the Examiner states is contained within Razavi. However, the Examiner is in error. There might well have been motivation to reduce fouling in Razavi, but that motivation did not include a teaching or suggestion to raise the temperature of Razavi's metallocene/activator combination step. Absent some teaching or suggestion to such a temperature elevation (as contained in Applicants' claims) "[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification" *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). And "[t]here must be a reason or suggestion in the art for selecting the procedure used, other than the knowledge learned from the applicant's disclosure" *In re Dow Chem. Co. v. American Cyanamid Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531-32 (Fed. Cir. 1988), and in the instant case, there is no such reason or suggestion in the art for selecting the procedure used. Accordingly, neither of the two Razavi documents render the present claims Obvious

Withdrawal of the Rejections is respectfully requested.

#### Rejection Under 35 USC § 102

7. *Claims 1, 3, 5,-10, 14-22 and 24-29 stand Rejected under 35 USC § 102(e) as Anticipated by US 6,420,501 (Uwai).*

The claims have been amended and the temperature of the support added is in every case, outside that temperature disclosed by the Uwai document.

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Withdrawal of the Rejection is respectfully requested.

**Rejection Under 35 USC § 103**

8. *Claims 1, 3, 5,-10, 14-22 and 24-35 stand Rejected under 35 USC § 103(a) as Obvious over (Uwai).*

The Examiner states that the reaction of the activated metallocene and the support above room temperature would be a step the routineer would "accomplish with only minor experimentation". Again, the Examiner is in error. The Examiner is using the "obvious to try" rationale, which is discussed above in reference to the Razavi documents, and it is no more acceptable as a rationale here as above. Further, there is no motivation to make such a change to Uwai, save for Applicants' disclosure, as the presently claimed temperature of the support is lower than that suggested by Uwai. As Uwai does not render the present claims Obvious for the reasons stated, withdrawal of the Rejection is respectfully requested.

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The claims are in condition for allowance.

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I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

May 30, 2006

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